

REMARKS

The Office Action mailed February 2003 rejected claims 1-9, 11, 18 and 26 were rejected under Section 102(b) as anticipated by Oles (6,047,130). Claim 10 was rejected under Section 103(a) over Oles and Kurashige (5,282,262). Claims 12-17, 19-22 and 24-25 were rejected under Section 103(a) as unpatentable over Oles and Oberg (5,870,771). Claim 23 was rejected as unpatentable over Oles, Oberg and Freeman (6,356,288). Claim 27 was rejected as unpatentable over Oles and Morris (6,453,361).

The §102 Rejection

Claims 1-9, 11, 18 and 26 were rejected under Section 102(b) as anticipated by Oles, which discloses a photographic camera synchronized to a video camera with a computer and viewing monitors that allows professional photography customers to visually determine the appropriate size of a portrait photograph and matching picture frame by displaying upon a viewer a perspective view of a video image of the photographic image and the matching picture frame within a simulated room image.

Applicants respectfully traverse the Section 102 rejection. Per MPEP Section 706.02, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. In Oles, all appearances used "size perspective" for video image. Column 2 line 1 of Oles states "The present invention overcomes these deficiencies by providing a method and apparatus that allows a customer to visually determine the appropriate size of a portrait photograph and matching picture frame by displaying upon a portrait display viewer a perspective view of a combined video image of the photograph and the matching frame within a simulated room image." Further, Column 5 line 31-35: "The present invention as depicted in FIG. 5 allows the customer or operator to change the perspective of the video image (and the size of the resulting portrait) as well as move and position the combined image within the simulated room setting image." This is further supported by the fact that all Oles figures show a frontal view of the picture. The fact that the monitor showing the simulated picture(s) is shown in a 3D perspective view further supports the contention that the "perspective view" in Oles is not the perspective view as claimed.

In sum, the "perspective" term in Oles relates to the "size of the resulting portrait" and includes the frame image shown in a head-on view. In contrast, each of the independent claims recite wherein the frame image is not shown in a head-on view. In one embodiment of the present invention, a discussion of the "perspective view" is provided on page 6 as follows:

A "perspective frame image" is an image that shows an in-perspective view of a frame. In other words, the frame in such a perspective frame image is not shown in a head-on view. For example, a frame can be arranged in a typical scene in which the frame might be displayed (e.g., on a table) and then a digital camera can be used to capture a perspective image of the frame as it appears in the scene. Also, a white piece of paper (or other suitable material) can be mounted in the frame where an image print would be displayed. As a result, the perspective frame image will include a white region located where an image print would be visible in the frame (also referred to here as the "picture area"). An example of such a perspective frame image 300 having a picture area 302 is shown in FIG. 3A.

As shown above, Oles cannot anticipate the invention as it only shows a head-on view.

Additionally, Oles fails to show at least the claimed "providing an enhanced edit set including user manipulable tools for editing either the picture or the frame in the perspective view." Oles shows no such enhanced edit set. Oles' Fig. 3 description is reproduced below:

FIG.3 illustrates the operator using the present invention to view the selected video image 24 within the selected picture frame image 26. The selected video image is initially transposed as a 5"x7" image on video portrait viewer 20 with the operator being able to manipulate or post-process the video image in a variety of ways including reducing or enlarging the image, rotating the image, or repositioning the image on the video portrait viewer 20. The present invention includes previously stored images of picture frames available for viewing so that the operator can go through the picture frame images to find one suitable for the portrait. Essentially, the present invention incorporates a picture frame catalog within its storage system, with the further ability to combine the selected video image 24 with the selected picture frame image 26 to form a combined image as depicted in FIG. 3. The present invention allows a photographer to show the customer every existing style and color of picture frame available. The customer is then able to select from the many styles and types of picture frames that will best complement and display the portrait. All of the present invention's post processing capability is available for use on the combined picture frame image and video image.

Oles describes item 22 as "Option menu 22 provides user access to all of the functions of the present invention such as reducing or enlarging the selected video image." However, nowhere in Oles does it show specifically the "providing an enhanced edit set including user manipulable tools for editing either the picture or the frame" in the perspective view (wherein the frame image is not shown in a head-on view) as discussed above. Here, Oles shows a 2D rendering of the picture or the frame from a frontal view. It does not show user manipulable tools for editing either the picture or the frame in the perspective view.

Applicants respectfully traverse the Section 102 rejection. Per MPEP Section 706.02, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Here, Oles shows neither the perspective view nor the tools to edit the picture or the frame in the perspective view.

In sum, Oles cannot anticipate claim 1 since it fails at least one claimed element. Since a Section 102 rejection requires EACH and EVERY element to be present, Oles cannot anticipate any of the independent claims and those dependent therefrom. Withdrawal of the Section 102 rejection on claims 1-9, 11, 18 and 26 is respectfully requested.

The §103 Rejection

Claim 10 was rejected under Section 103(a) over Oles and Kurashige (5,282,262). Claims 12-17, 19-22 and 24-25 were rejected under Section 103(a) as unpatentable over Oles and Oberg (5,870,771). Claim 23 was rejected as unpatentable over Oles, Oberg and Freeman (6,356,288). Claim 27 was rejected as unpatentable over Oles and Morris (6,453,361).

First, these claims are allowable as they depend from allowable claim 1. Further, none of the references show the specifics of the dependent claims. To illustrate, as to claim 10, neither Oles nor Kurashige show displaying of the image and frame in the perspective view and the user manipulable tools for editing either the picture or the frame in the perspective view. Kurashige relates to a hardware apparatus for transforming a two-dimensional input video signal onto a three-dimensional surface and for depicting illumination thereof by a spot light source transforms the two-dimensional video signal in accordance with a mapping data signal onto the three-dimensional surface. However, there is no specifics of displaying of the image and frame in the perspective view and the user manipulable tools for editing either the picture or the frame in the perspective view, and there is no suggestion of combining Kurashige with Oles. Withdrawal of the rejection of claim 10 is requested.

To further illustrate, as to claims 12-17, 19-22 and 24-25, Oberg does not show providing a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame. The frame molding 62 shown in FIG. 3 is shown as a top view, indicating that it is NOT a perspective view but a 2D top view. Further, the superimposition operation mentioned in Oberg is consistent with the 2D top view since in a 2D view, differing layers only need to be super-imposed to provide a combined view.

Moreover, Oberg fails to show the "providing an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view." Here, Oberg's column 6, line 1-6 shows the image editing software and, as discussed above, Oberg does not show the perspective view. However, Oberg is absolutely devoid of the claimed specifics of an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view. Oberg is completely silent on where the editing set is placed relative to

the frame image. Oberg's Fig. 3 shows only the frame and nothing else. Withdrawal of the rejection of claims 12-17, 19-22 and 24-25 is requested.

Claim 27 was rejected under Section 103(a) as unpatentable over Oles and Morris (6,453,361). Morris relates to an online system with a server for communicating with both client devices and photo-sharing web sites over a network.

Applicants respectfully traverse the rejection of claim 27. Here, neither Oles nor Morris shows instructions to provide a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame; map the picture image to the picture portion of the frame image in order to generate the frame prototype image; and provide an enhanced edit set along with the frame image, the enhanced edit set including user manipulatable tools for editing either the picture or the frame in the perspective view. Hence, claim 27 is patentable over Oles and Morris for each of these reasons.

Secondly, Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Oles reference with Oberg so as to produce the claimed invention. Further, Applicants fail to identify any motivation to modify the reference teaching so as to provide uploading of images that were edited and/or previewed in the perspective view arrangements as presently claimed. Applicants point out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Morris, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 27. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in either Oles, Kurashige, Oberg or Morris reference, or knowledge of those skilled in the art, to provide a frame image showing the frame in a perspective view, the frame image having a picture portion corresponding to the portion of the frame used to view a picture mounted in the frame; map the picture image to the picture portion of the frame image in order to generate the frame prototype image; and provide an enhanced edit set along with the frame image, the enhanced edit set

including user manipulatable tools for editing either the picture or the frame in the perspective view, and to upload the resulting image to a server, *prima facie* obviousness of the claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of claim 27 and all claims be withdrawn.

CONCLUSION

Applicants respectfully submit that all claims are in condition for allowance. Withdrawal of the rejection is respectfully requested.

Please charge any required small entity fees to Deposit Account 501861.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,


Bao Tran

Reg. 37,955